

REMARKS

Claims 28, 32 and 39 have been amended to overcome a minor informality. Otherwise, claims 19-46 are presented without amendment in the light of the remarks and authorities of record.

The office action states:

Claims 28 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 28 and 32 recites the limitation "a control" or "the control" but independent claim 19 has a first and second control, so it is not clear as to which of the two controls is being referred to in claims 28 and 32. P.2.

Claims 28 and 32 have been amended by deleting "a control" and "the control." Accordingly, withdrawal of this ground of rejection of claims 28 and 32 is respectfully requested.

The office action states:

Claims 19-24, 27-30, 38-40, 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over JAEGER et al. (US Patent No: 5,982,355) in view of WEISS et al. (US Patent No: 6,225,980 B 1).

As for claim 19, JAEGER teaches of a system for accepting user input (Fig.!, 11), comprising: a first control (Fig. 24) configured to select a media source in response to an actuation of the first control (Fig. 24) by. a user; a second control (Fig.], 17), a display (Fig.6, 13) for displaying one of the media source, mode and media content item in column 11, lines 15-30 and in column 13, lines 30-40.

JAEGER fails to teach that the second control has two degrees of freedom in actuation configured to choose a mode from a set of modes for the selected media source in response to an actuation of the first degree of freedom of the second control by the user, wherein actuation of the second degree of freedom by the user of the second control is configured to identify a media content item selection.

WEISS teaches that the second control (Fig. 2) has two degrees of freedom in actuation configured to choose a mode from a set of modes for the selected media source in response to an actuation of the first degree of freedom (Fig.2, rotatable dial, 20) of the second control by the user, wherein actuation of the second degree of freedom (Fig.2, depressing dial, 20) by the user of the second control is configured to identify a media content item selection in column 7, line 48.

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the second control with two degrees of freedom as taught by WEISS with the controller for accepting user input device of JAEGER in order to provide to users a user input interface that is a combination of a rotary dial and a push button in attempts to increase the speed and ease of the user's operation (WEISS: column 2, line 37).

As for claim 20, JAEGER teaches of a pressure member (Fig.32, 201) coupled to a plurality of switches (Fig.32, 206), the pressure member (Fig.32, 201) having multiple sections (Fig.32, 202), wherein each section of the multiple sections (Fig.32, 202) is associated with a switch of the plurality of switches (Fig.32, 201) and wherein the pressure member (Fig.32, 201) is positioned in relation to the plurality of switches (Fig.32, 201) such that when a force is applied by a user to one of the multiple sections, the pressure member (Fig.32, 201) transmits a resulting force to a switch (Fig.32, 201) associated with the one of the multiple sections (Fig.32, 202) thereby causing actuation of the switch (Fig.32, 201) associated with the one of the multiple sections (Fig.32, 202) in Fig. 32-33 and in column 18, lines 43-46. (NOTE: That although JAEGER fails to illustrate all the various control systems in one figure, it would have been obvious to include the various buttons and controllers of JAEGER into one apparatus in order to provide a multi purpose remote control with multi functional buttons. JAEGER: column 2, line 35).

As for claim 21, JAEGER teaches of a control comprises a shaft (177), wherein the shaft (177) is mounted within a void of the pressure member and secured by a fastener in Fig. 29 and in column 17, line 35.

As for claim 22, JAEGER fails to teach of the system delays, for a predetermined time, before executing one of a user media source selection, mode selection and media content item selection.

Examiner takes OFFICIAL NOTICE that it is well known in the art to have system delays, for a predetermined time, before executing one of a user media source selection, mode selection and media content item selection.

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine include a system delay with the controller of JAEGER in order to wait for the system to register the user's choice and in order to better ensure that the user is satisfied with that particular selection and not in the midst of deciding.

As for claim 23, JAEGER teaches that upon the occurrence of one of a user media source selection, mode selection, and media content item selection, the system provides a sub-menu of options to the user in column 6, line 65.

As for claims 24 and 28, JAEGER teaches that a display is configured to provide a visual confirmation of the media source selected {claim 24} and user input {claim 28} in column 15, lines 45-50 and in column 6, line 65.

As for claim 27, JAEGER teaches that the display is a touch screen and wherein the touch screen is configured to process a user input in column 18, lines 40-45.

As for claims 29-30 JAEGER teaches that the display is configured to provide a visual confirmation in forms of graphics and text of the media source selected in column 6, line 65 and in column 17, line 20.

As for claim 38, JAEGER as modified by WEISS teaches that a second control (JAEGER: Fig.32, 206) is positioned in front of the display (JAEGER: Fig.32, 202) in JAEGER: column 11, lines 15-30 and in column 13, lines 30-40, wherein the second control accepts actuation of the second degree of freedom by the user, as a user input in WEISS: column 7, line 48.

As for claim 39, JAEGER teaches of a system for accepting user input (Fig.32), comprising: at least one switch (206); a display (Fig.32, 202), wherein the display (Fig.32, 202) depicts menu options including: media content information; control options, wherein the control options are displayed on the display near the switch (Fig. 24); a pressure member (Fig.32, 201) disposed over the display (Fig.32, 202); the pressure member (Fig.32, 201) being configured to accept a force exerted by a user within a section of the pressure member (Fig.32, 201); the pressure member (Fig.32, 201) further coupled to the at least one switch (Fig. 24) such that a resulting force transmitted by the pressure member (Fig.32, 201) in response to a user applied force causes a switch actuation in Fig. 32 and in column 18, lines 43-46. JAEGER teaches that at least a portion of the control is optically transparent, wherein the control is positioned over the display and wherein information displayed by the display is visible through the control in column 20, lines 63-65.

JAEGER fails to teach of at least one control, configured to accept one of a push and WEISS teaches of at least one control, configured to accept one of a push and turn column 7, line 48.

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the second control with two degrees of freedom as taught by WEISS with the controller for accepting user input device of JAEGER in order to provide to users a user input interface that is a combination of a rotary dial and a push button in attempts to increase the speed and ease of the user's operation (WEISS: column 2, line 37).

As for claim 40, JAEGER teaches that at least a portion of the at least one control is optically transparent, wherein the at least one control is positioned over the display and wherein information displayed by the display is visible through the at least one control in column 20, lines 63-65.

As for claim 44, JAEGER fails to teach that the control has two degrees of freedom in actuation, and wherein actuation of the first degree of freedom is associated with selection of a media source, and the second degree of freedom is associated with control of system volume.

WEISS teaches that the control has two degrees of freedom in actuation, and wherein actuation of the first degree of freedom (Fig.2, rotatable dial, 20) is associated with selection of a media source, and the second degree of freedom (Fig.2, depressing dial, 20) is associated with control of system volume in column 7, line 48.

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the second control with two degrees of freedom as taught by WEISS with the controller for accepting user input device of JAEGER in order to provide to users a user input interface that is a combination of a rotary dial and a push button in attempts to increase the speed and ease of the user's operation (WEISS: column 2, line 37).

As for claim 45, JAEGER teaches of a system for accepting user input in a media player, comprising: a display for displaying one of the media source, mode and media content item; at least one control is disposed over the display in column 11, lines 15-30 and in column 13, lines 30-40. JAEGER teaches that at least a portion of the control is optically transparent, such that at least a portion of the display is visible through the at least one control in column 20, lines 63-65.

JAEGER fails to teach one control has two degrees of freedom.

WEISS teaches at least one control has two degrees of freedom in column 7, line 48.

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the second control with two degrees of freedom as taught by WEISS with the controller for accepting user input device of JAEGER in order to provide to users a user input interface that is a combination of a rotary dial and a push button in attempts to increase the speed and ease of the user's operation (WEISS: column 2, line 37-40).

As for claim 46, JAEGER teaches of a media player comprising: a plurality of switches; a display for displaying one of the media source, mode and media content item; a pressure member coupled to at least one of the plurality of switches, the pressure member disposed over the display, the pressure member being configured to accept a force exerted by a user within a section of the pressure member; and two controls, wherein each of the two controls is located to one side of the display in column 11, lines 15-30 and in column 13, lines 30-40. JAEGER teaches that at least a portion of the display is visible through the pressure member in column 20, lines 63-65.

JAEGER fails to teach the controls have two degrees of freedom in actuation and that the media player is used for a motor vehicle.

WEISS teaches at least one control has two degrees of freedom in column 7, line 48.

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the second control with two degrees of freedom as taught by WEISS with the controller for accepting user input device of JAEGER in order to provide to users a user input interface that is a combination of a rotary dial and a push button in attempts to increase the speed and ease of the user's operation (WEISS: column 2, line 37-40).

Although both JAEGER and WEISS lacks the explicit teachings that their apparatus is able to be utilized in a motor vehicle, the body of the claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose of intended use of the invention rather than any district definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to the claim construction. Pp. 2-9.

This ground of rejection is respectfully traversed.

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

"Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.'" *In re Laskowski*, 10 U.S.P.Q. 2d 1397, 1398 (Fed. Cir. 1989).

"The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so." *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original, footnotes omitted).

"The critical inquiry is whether 'there is something in the prior art as a whole *to suggest* the desirability, and thus the obviousness, of making the combination. [citing *Lindemann* with emphasis added.]'" *Fromson v. Advance Offset Plate, Inc.*, 225 U.S.P.Q. 26, 31 (Fed. Cir. 1985).

As the Federal Circuit Court of Appeals said in *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999):

Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'

And in *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000), the Court said:

[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.* [*Dembiczak*]. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *See In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998), *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *See B. F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996).

Nothing in the references suggests the desirability of combining what is there disclosed to meet the limitations of the rejected claims.

The reliance on the secondary reference is inapposite. The claims call for the control with two degrees of freedom. The secondary reference in column 2, lines 32-43, refers to U.S. Pat. App. 08/399,203 for further details of the VuMan3 computer that was the parent of U.S. Patent No.: 5,959,611, which discloses a rotary switch or dial 22 and separate on/off switches 24a, 24bB and 24c, all having only one degree of freedom. Thus, the secondary reference does not disclose a control with two degrees of freedom, and it would be impossible to combine the primary and secondary references to meet the limitations of the claims rejected on them.

"Moreover, we observe that even if these references were combined in the manner proposed by the examiner, that which is set forth in appellant's claims . . . would not result." *Ex parte Bogar*, slip op. p.7 (BPA&I Appeal No. 87-2462, October 27, 1989). "Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed." *Ex parte Schwarz*, slip op. p.5 (BPA&I Appeal No. 92- 2629 October 28, 1992). "Although we find nothing before us indicating why it would be desired to combine the references in the manner urged by the examiner, it is clear to us that such a modification by itself would not result in that which is set forth in the claims." *Ex Parte Kusko*, 215 U.S.P.Q. 972, 974 (BPA&I 1981).

That it is impossible to combine the references to meet the limitations of the rejected claims is reason enough for withdrawing the rejection of them.

Furthermore, the primary reference discloses switches 17 on top of display 13. Conductor 69 electrically connect the switches to a circuit and are made of a transparent material or otherwise arranged to minimally interfere with images projected by display 13. Components of the control signal producing circuit 81 are in marginal region 88 of flat panel display 89 that is

outside of the image area defined by the screen 66. Alternately, components of circuit 81 can be at the back of screen 66 or at a remote location. Thus the primary reference is concerned with minimizing blocking images on the display with other components. The only item on the display is the switch (button) itself. The connecting wires from the switch are transparent or otherwise arranged to minimally interfere with an image on the display. The reference discloses no circuitry on the display but discloses circuitry to the side of the display, under the display or at a remote location.

The secondary reference discloses a large complicated switch assembly that includes an integrated circuit board 18, rotatable dial 20, joy stick 24, wheels 47, magnets 53, Hall effect sensors 55, three pistons 59, three springs 62. Putting this complicated switch assembly on display 13 in the primary reference would destroy the function of the primary reference in having switches 17 minimized in complexity to minimally block the display.

That the substitution proposed by the Examiner would destroy the function of the primary reference is another reason for withdrawing the rejection of claims on the combination of these references.

In Ex parte Sternau, 155 U.S.P.Q. 733, 735 (Bd. of Appeals 1967) the Board said:

However, there is nothing in the disclosures of [primary reference] Young and [secondary reference] Haslacher that would teach the Examiner's proposed combination or any reason for making it. In fact, the proposed combination would destroy the Young apparatus for its intended purpose. Thus, we will reverse the rejection of claims 44 and 45 for this reason.

Accordingly, withdrawal of the rejection of claims 19-24, 27-30, 38-40 and 44-46 as unpatentable over the primary and secondary references is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in

the references regarded as corresponding to each limitation in at least a rejected independent claim and quote verbatim the language in the references regarded as suggesting the desirability of combining what is there disclosed to meet the limitations of these rejected claims.

The office action states:

Claims 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over JAEGER et al. (US Patent No: 5,982,355) in view of WEISS et al. (US Patent No: 6,225,980 B 1) and HOLZ AUF DER HEIDE et al. (US Application No: 2004/02034111)

As for claims 36-37, JAEGER and WEISS fails to teach that the system is configured to provide an audible confirmation of the media source selected and that the audible confirmation of the media source selected is a synthetic voice.

HOLZ AUF DER HEIDE teaches that the system is configured to provide an audible confirmation of the media source selected and that the audible confirmation of the media source selected is a synthetic voice in section [0028].

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the use of storing synthetic voice for playback as taught by HOLZ AUF DER HEIDE with the controllers of JAEGER and WEISS in order to provide an audible method to notify the users of their selection. Pp.9-10.

This ground of rejection is respectfully traversed. Claims 36 and 37 are dependent upon and include all the limitations of parent claim 19, and the reasoning set forth above in support of the patentability of claim 19 on the primary and secondary references is sufficient to support the patentability of claims 36 and 37 so that further discussion of the tertiary reference is submitted to be unnecessary.

The office action states:

Claims 25-26, 31-35, 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over JAEGER et al. (US Patent No: 5,982,355) in view of WEISS et al. (US Patent No: 6,225,980 B 1) and CAPPS et al. (US Patent No: 6,803,905 B 1).

As for claims 25, 31, 35, 41-42, JAEGER teaches that the display is configured to provide a visual confirmation of the media source selected in column 6, line 65 and in column 17, line 20.

JAEGER and WEISS fails to teach that the display displays a color cue based upon the media source selected (claim 25); that the visual confirmation is a color change (claims 31, 32); where the display or at least one control displays a color to provide user feedback {claims 41-42}.

CAPPS teaches that the display displays a color cue based upon the media source selected {claim 25}; that the visual confirmation is a color change {claims 31, 32}; where the display or at least one control displays a color to provide user feedback {claims 41-42} in column 4, line 44.

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine to include a color change confirmation as taught by CAPPS with the control system as taught by JAEGER and WEISS in order to improve visual feedback to an operator (see CAPPS: column 1, line 10).

As for claim 26, JAEGER teaches that the display provides a position indicator depicting to the user, the relative position of a selected media content item within a browsable list of media content items, wherein the position indicator is displayed in a radial format in column 17, lines 15-20.

As for claim 32, JAEGER teaches that at least a portion of the control is optically transparent, wherein the control is positioned over the display and wherein information displayed by the display is visible through the control in column 20, lines 63-65.

As for claims 29-30 JAEGER teaches that the display is configured to provide a visual confirmation in forms of graphics and text of the media source selected in column 6, line 65 and in column 17, line 20.

As for claim 43, JAEGER teaches that at least one control displays a symbolic representation of a selected one of the media content source, mode and media content item in Fig. 32-33. Pp. 10-12.

This ground of rejection is respectfully traversed. These claims depend upon claim 19 or claim 39 and the reasoning set forth above in support of the patentability of these parent claims on the primary and secondary references is submitted to support patentability of claims 25, 26, 31-35 and 41-43 so that further discussion of the tertiary reference is submitted to be unnecessary.

In view of the foregoing amendments, authorities, remarks and the inability of the prior art, alone or in combination, to anticipate, suggest, or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in condition for allowance, and notice thereof is respectfully requested. Should the Examiner believe the application is not in a condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at 617-521-7014 to discuss what additional steps the Examiner believes are necessary to place the application in a condition for allowance.

Please apply any charges or credits to Deposit Account No. 06-1050, order 02103-551001.

Respectfully submitted,
FISH & RICHARDSON P.C.

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